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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,318

04/10/2007

Mark McHugh

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07/09/2010

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EXAMINER

TENTONI, LEO B

ART UNIT

PAPER NUMBER

1791

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,318	<b>Applicant(s)</b> MCHUGH ET AL.	
	<b>Examiner</b> Leo B. Tentoni	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06092006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-19 and 23-29 in the reply filed on 20 May 2010 is acknowledged.
2. Claims 20-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 20 May 2010.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23, line 3, "can" renders the claim indefinite because it is not clear if the vessel is, or is not, pressurized.

In claim 23, lines 6-7, "can be" renders the claim indefinite because it is not clear if the polymeric formulation is, or is not, delivered.

In claim 23, line 9, "can be" renders the claim indefinite because it is not clear if the polymeric formulation is, or is not, electrospun.

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 23-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Balkus, Jr. et al (U.S. Patent Application Publication 2003/0168756 A1).

Balkus, Jr. et al (see the entire document, in particular, paragraphs [0006], [0007], [0019], [0055] - [0060], [0064], [0083] and [0084]; Figure 1) teaches an electrospinning apparatus including a source of pressurized polymeric formulation, a collection vessel, a flow tube in communication with the source of pressurized polymeric formulation, a target in the collection vessel, and a voltage source.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Balkus, Jr. et al (U.S. Patent Application 2003/0168756 A1) as applied to claims 23-28 above, and further in view of Dubson et al (U.S. Patent Application Publication 2004/0094873 A1).

Balkus, Jr. et al does not explicitly teach an apparatus in which the flow tube is grounded (Balkus, Jr. et al teaches a flow tube and an electrically charged electrode near the target). Dubson et al (see the entire document, in particular, paragraph [0069]) teaches an electrospinning apparatus including a grounded flow tube, and such would have been obvious to one of ordinary skill in the art at the time the invention was made in the

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apparatus of Balkus, Jr. in view of Dubson et al in order to manufacture fibers by electrospinning.

10. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balkus, Jr. et al (U.S. Patent Application 2003/0168756 A1).

Balkus, Jr. et al (see the entire document, in particular, paragraphs [0006], [0007], [0019], [0055] - [0060], [0064], [0083] and [0084]; Figure 1) teaches an electrospinning process including the step of electrospinning a pressurized polymer formulation into a collection vessel to form polymer fibers (on a target). Balkus, Jr. et al does not explicitly recite that the collection vessel is pressurized. However, this would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Balkus, Jr. et al because Balkus, Jr. et al teaches placing the polymer formulation under pressure and forcing the polymer formulation into the vessel, which results in pressurization of the vessel (note also that the pressurized polymer formulation of Balkus, Jr. et al may contain water (e.g., as a solvent), which is one of the possible pressurized fluids). The particular pressure and temperature in the collection vessel depends on, among others, the particular polymer (and optional solvent) used.

11. Claims 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balkus, Jr. et al (U.S. Patent Application Publication 2003/0168756 A1).

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Balkus, Jr. et al (see the entire document, in particular, paragraphs [0006], [0007], [0019], [0055] - [0060], [0064], [0083] and [0084]; Figure 1) teaches a process of making fibers including the steps of forming fibers by electrospinning apolymeric formulation into a collection vessel, contacting the polymer fibers with pressurized fluid, and recovering the polymer fibers. Balkus, Jr. et al does not explicitly teach that the collection vessel contains pressurized fluid. However, this would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Balkus, Jr. et al because Balkus, Jr. et al teaches placing the polymer formulation under pressure and forcing the polymer formulation into the vessel, which results in pressurization of the vessel (note also that the pressurized polymer formulation of Balkus, Jr. et al may contain water (e.g., as a solvent), which is one of the possible pressurized fluids). The particular pressure and temperature in the collection vessel depends on, among others, the particular polymer (and optional solvent) used.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (571) 272-1209. The examiner can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can

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be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leo B. Tentoni/  
Primary Examiner, Art Unit 1791